

Please amend claim 1 as follows:

1. (Twice Amended) A heat-sealable multi-ply filter material, comprising: at least one ply containing natural fibers and one ply containing biodegradable, thermoplastic fibers made of a member selected from the group consisting of aliphatic polyesteramides, partially aromatic polyesteramides, aliphatic polyesters, partially aromatic polyesters, aliphatic polyesterurethanes, partially aromatic polyesterurethanes, aliphatic polyestercarbonates and aliphatic-aromatic polyestercarbonates; and a second ply, wherein said ply containing natural fibers and said ply containing biodegradable, thermoplastic fibers are connected by interpenetration of said thermoplastic fibers and said natural fibers to form pores.

REMARKS

Claims 1, 3-5, and 8-17 are pending in the application. Claim 1 has been amended as set forth above in order to more particularly point out and distinctly claim the subject matter that Applicants regard as their invention.

The Examiner has rejected claims 1, 3, 5, 10, and 16-17 under 35 U.S.C. §102(b) as being anticipated by JP 125128 to So et al (hereinafter "So et al"). The examiner has refused to give patentable weight to the preamble recitations of claims 1 and 16-17, on the grounds that those preambles merely recite the intended use of the structure defined in the claims, and because the structural limitations are able to stand alone, the bodies of the claims do not depend upon the preambles for completeness.

Applicants respectfully disagree, and submit that the preambles in amended claim 1 ("heat-sealable filter material"), claim 16 ("a tea bag"), and claim 17 ("a coffee bag") must be

read to incorporate structure necessary to support the claim. The preambles in these claims distinctly point out that which the inventors consider their invention. In claim 1, the language "a filter material" is critical to defining the invention as a **filter** material, which by its very nature has a *permeable* structure. A material which is impermeable cannot, under any applicable definition, be described as a "filter." Similarly, the language "a tea bag" in claim 16 and "a coffee bag" in claim 17 define the invention as a bag made of material having a structure which is permeable to water, and which is not rapidly degraded when exposed to water. A bag that is impermeable, on one hand, or rapidly water soluble on the other hand, cannot serve as the structure of a tea or coffee bag, which under any applicable definition is understood to be permeable to water and reasonably insoluble in water.

It is respectfully submitted that the terms "filter," "tea bag" and "coffee bag" import structural limitations which are just as necessary to describe the structure of the invention as the preamble term "hammer" is necessary to a claim for a tool which strikes nails. The terms "filter," "tea bag" and "coffee bag" must be accorded patentable weight since each gives meaning to its respective claim by adding structural limitations necessary to completely describe the invention. These preamble terms therefore should not be read as mere statements of intended use. See Loctite Corp v. Ultraseal Ltd, 781 F.2d 861, 864-868 (Fed. Cir. 1985) (court determined that "anaerobic" phrase in preamble is a necessary limitation on the claims because it "breathes life and meaning into the claims"); see also Freund Industrial Co. Ltd. V. Driam Metallproduct GmbH & Co. KG., 12 USPQ2d 1641 (S.D. N.Y. 1989)(preamble "an apparatus for applying a coating on tablets comprising..." constitutes a limitation on the claim so that the appropriate field of prior art is tablet coating machines, not industrial drying machines generally). It is

respectfully submitted that the amendment to claim 1 (adding "heat-sealable") must also be afforded patentable weight by the Examiner.

In addition to the Examiner's failure to properly consider the preamble language of the claims, So et al describes a laminated non-woven multi-ply material which is clearly distinguishable from the non-laminated material of amended claim 1. So et al discloses a laminated material having plies connected by punctiform or thermal weld zones formed upon application of heat or mechanical pressure (see Page 3, Paragraph 0009 et seq.). By contrast, the material of amended Claim 1 is a multiple ply filter material wherein the first ply and said second ply are connected only by interpenetration of the thermoplastic fibers and natural fibers. Therefore, no adhesive, mechanical pressure, or thermal welded joints or the like are necessary. The structures of these two very different materials are clearly patentably distinguishable.

For all of the above reasons, it is respectfully submitted that independent claims 1, 16, and 17 are now in condition for allowance. Accordingly, since claims 3, 4, 5, and 8-15 depend from claim 1, it is believed that the dependent claims are also allowable.

Without limiting the prior arguments, Applicant notes that the Examiner has rejected claim 4 under 35 U.S.C. §102(b) as being clearly anticipated by So et al. As previously described herein, Applicant's amendments to claim 1 provide structural limitations which are not disclosed by So et al. Further, as noted by the Examiner, So et al does not disclose the air permeability of the natural fiber ply of Applicant's invention. In fact, as set forth above, So et al. does not disclose that any layer of the material is permeable, and therefore does not describe a material which is a filter material. In any event, Applicant's amendments to claim 1 are sufficient to overcome this objection.

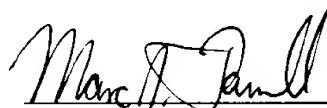
Alternatively, the Examiner has rejected claim 4 as obvious over So et al under 35 U.S.C. §103(a). The differences between Applicant's filter material as described in claim 4 and the material disclosed in So et al are not such that the subject matter as a whole would be obvious to one skilled in the art. As previously pointed out by the Examiner, the So et al patent does not disclose that the natural fiber layer should be permeable to air. Nor does So et al provide any motivation or suggestion that the natural fiber layer be permeable to air. Moreover, since So et al is void of any mention of air permeability for the natural fiber layer, and since So et al contains no motivation or suggestion to one skilled in the art to provide air permeability, the claimed air permeability of 300 to 4000 l/m² sec (DIN 53 887) in claim 4 cannot be obvious. In any event, the claimed air permeability range is necessary to provide a material structure which provides filter properties and characteristics. The air permeability range as claimed was scientifically determined and optimized by Applicant, and provides a non-obvious, patentable structural limitation to the subject matter of the invention as claimed. For all these reasons, Applicant respectfully requests that the rejection of claim 4 be withdrawn.

Lastly, the Examiner has rejected claims 8-9 and 11-15 as unpatentable under 35 U.S.C. §103(a) over So et al in light of Pophausen et al, U.S. Patent No. 5,928,739. Applicant respectfully submits that these references cannot be effectively combined, and that the Examiner has failed to state a prima facie case of obviousness. There is no teaching, suggestion, or motivation provided in So et al or Pophausen et al which supports the proposed combination. The mere fact that features from these two inventions may possibly be combined in some fashion does not render the resulting combination obvious unless the prior art suggests or provides motivation for the combination. See MPEP § 2143.01. The examiner has therefore not provided

proper support for the conclusion that the proposed combination is an obvious one. Further, given that Pophausen et al describes a dense material which is watertight and nearly airtight, one skilled in the art would not look to Pophausen et al in connection with the construction of a material suitable for use as a filter, or for coffee bags, tea bags, and the like. Therefore, Applicant respectfully submits that claims 8-9 and 11-15 are allowable. It is respectfully requested that the rejection of claims 8-9 and 11-15 under 35 U.S.C. §103(a) be withdrawn.

In view of the foregoing Amendment and Remarks, it is respectfully submitted that claims 1, 3-5, and 8-17 define patentable subject matter and are allowable. Reconsideration is therefore requested, and a notice of allowance is earnestly solicited. Applicant also respectfully requests the courtesy of a telephone call should the Examiner believe the progress of the application would be advanced thereby, as permitted by MPEP §408.

Respectfully submitted,



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